

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1, 6, 7, 16, 20 and 23 under 35 U.S.C. § 102(a) as being anticipated by JP 02000279418A to Suzuki (hereinafter "Suzuki"). Additionally, the Examiner rejects claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent No. 5,782,834 to Lucey et al., (hereinafter "Lucey").¹ Furthermore, the Examiner rejects claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki. Still further, the Examiner rejects claims 10, 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent No. 6,066,102 to Townsend et al., (hereinafter "Townsend"). Lastly, the Examiner rejects claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent No. 6,110,127 to Suzuki, (hereinafter "Suzuki '127").

In response, independent claims 1 and 10 have been amended to clarify their distinguishing features. Specifically, claim 1 has been amended to recite medical instrument comprising:

a swingable operating section formed of a pair of forceps, each of which rocks individually around a respective first rocking axis corresponding thereto;

a tubular sheath having a distal end portion situated on a proximal end side of the operating section, the distal end portion having a circular-section portion having a circular cross section perpendicular to a longitudinal central axis of the tubular sheath and a pair of parallel flat portions symmetrically formed on opposite sides of the circular-section portion and in sliding contact with respective proximal end portions of the forceps;

¹ Applicants believe the Examiner intended this rejection to be of claim 17, not claim 18 based on the subject matter discussed in the body of the rejection which appears to track the features of claim 17.

a pair of manipulators which advance and retreat along the longitudinal central axis of the tubular sheath, thereby rocking the forceps around the first rocking axis; and

a pair of junctions which respectively connect the manipulators for rocking motion around a second rocking axis to the forceps in the flat portions, the junctions being situated substantially on a reference plane containing the longitudinal axis of the tubular sheath and extending parallel to the second rocking axis, when the operating section is closed;

wherein the first rocking axis of each forceps is not on the reference plane when the operating section is closed.

Claim 10 has been amended to recite a medical instrument comprising:

a swingable operating section formed of a pair of forceps which rock individually around a rocking axis corresponding thereto;

a tubular sheath having a distal end portion situated on the proximal end side of the operating section, the distal end portion having a circular-section portion having a circular cross section perpendicular to a longitudinal central axis thereof and a pair of flat portions formed by cutting the opposite sides of the circular-section portion and in sliding contact with the respective proximal end portions of the forceps, and

a pair of junctions formed integrally with the flat portions so as not to project into the bore of the distal end portion, said junctions being situated substantially on a reference plane when the operation section is closed;

wherein the rocking axis of each forceps is not on the reference plane when the operating section is closed.

The amendment to claims 1 and 10 is fully supported in the original disclosure, such as at original claim 17. Consequently, claim 17 has been canceled. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claims 1 and 10.

As discussed above in footnote 1, although the Examiner does not reject claim 17 in the Official Action, Applicants believe that the rejection of claim 18 at paragraphs 12 and 13 of the Official Action is intended to be a rejection of claim 17. In such rejection, the Examiner admits that Suzuki does not show the feature of the rocking axis of each forceps not

being on the reference plane (containing the junctions and longitudinal axis) when the operating section is closed. However, the Examiner argues that Lucey shows such a feature due to the curvature of the distal end section. Applicants respectfully disagree for at least the following reasons.

The Examiner's reasoning assumes that the longitudinal axis cannot be curved. Figure 2 of Lucey clearly shows the rocking axis (74) of the forceps to be on the longitudinal axis of the tubular sheath (34), which curves and extends longitudinally with the curve of the tubular sheath. Thus, the longitudinal axis shown in Lucey follows the shape of the tubular sheath and intersects the rocking axis (74) of the forceps. Although Figure 2 illustrates the forceps as being open, there is no structure indicated in Lucey that would permit the rocking axis (74) to move from the position illustrated in Figure 2 when the forceps are closed.

Thus, neither Suzuki nor Lucey disclose or suggest the features of original claim 17, now recited in independent claims 1 and 10.

With regard to the rejection of claims 1, 6, 7, 16, 20 and 23 under 35 U.S.C. § 102(a), a medical instrument having the features discussed above and as recited in independent claim 1 is nowhere disclosed in Suzuki. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"² independent claim 1 is not anticipated by Suzuki. Accordingly, independent claim 1 patentably distinguishes over Suzuki and is allowable. Claims 6, 7, 16, 20 and 23 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 6, 7, 16, 20 and 23 under 35 U.S.C. § 102(a).

² Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

With regard to the rejections of claims 17-19, 21 and 22 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 17-19, 21 and 22 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 17-19, 21 and 22 under 35 U.S.C. § 103(a).

With regard to the rejection of claim 10 under 35 U.S.C. § 103(a), the same is not rendered obvious by the cited references because neither the Suzuki patent nor the Townsend patent, whether taken alone or in combination, teach or suggest a medical instrument having the features discussed above and recited in independent claim 10. Accordingly, claim 10 patentably distinguishes over the prior art and is allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 10 under 35 U.S.C. § 103(a).

Furthermore, new claim 24 has been added to further define the patentable invention. New claim 24 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 24. Applicants respectfully submit that new claim 24 is at least allowable as depending upon an allowable base claim (1).

Furthermore, Applicants respectfully submit that new claim 24 patentably distinguishes over the cited references independently of its base claim for at least the following reasons. According to the Examiner's argument, pins 103a and 103b of Suzuki corresponds with the junctions recited in claim 1. However, such pins 103a and 103b, as shown in Fig. 15, are situated on the reference plane, when the operation section is opened. Therefore, Suzuki does not disclose the features recited in new claim 24.

Lastly, The Examiner, at paragraph 5 of the Official Action responds to Applicants previous arguments. However, the Examiner's response is based on an error in Applicants previous response, specifically, at the last paragraph of page 8 of the previous response. In such paragraph, Applicants inadvertently used incorrect reference numbers from the Suzuki reference and would like to correct the record with the following correct paragraph (corresponding to the last paragraph of page 8 of the previous response).

In the embodiment of Figure 16 of Suzuki, the junction (~~link pin~~) 103a is situated on the reference plane. However, the link rod 105a and another ~~link rod pin~~ 104a (see Figures 15 and 16 of Suzuki) are also used. ~~Link rod pin~~ 104a connects the link 105a with the forceps and therefore can be said to together correspond to a junction of the claimed invention. However, it is evident that the ~~link pin~~ 104a is not situated on the reference plane from such figures. Therefore, in the device of Fig. 16, the link rod 105a and the ~~link pin~~ 103a correspond to parts of the manipulators, not to the junctions.

Applicants request re-consideration of such previous arguments in view of the above correction.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,
/Thomas Spinelli/
Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm